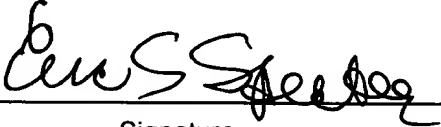


PTO/SB/33 (07-05)

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		GIES3001/ESS	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on		Application Number	Filed
		09/744,866	April 2, 2001
		First Named Inventor	
Signature		Frank AUSTRUP	
Typed or printed name		Art Unit	Examiner
		1642	S.J. Rawlings
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34</p> <p> Signature</p> <p>Eric S. Spector Typed or printed name</p> <p>703-683-0500 Telephone number</p> <p>September 7, 2005 Date</p> <p>Bacon &amp; Thomas, PLLC, Customer No. 23364</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of forms are submitted.</p>			



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In re U.S. Patent Application**

**Frank AUSTRUP, et al.**

**Application Number: 09/744,866**

**Filed: April 2, 2001**

**Examiner: Stephen J. Rawlings**

**Group Art Unit: 1642**

**Confirmation No.: 5636**

**For: CANCER CELLS FROM BODY FLUIDS CONTAINING CELLS,  
ISOLATION THEREOF AND AGENTS CONTAINING THE SAME**

**ARGUMENTS IN FAVOR OF REVERSAL  
OF REJECTION AND ALLOWANCE AT PRE-APPEAL BRIEF CONFERENCE**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**INTRODUCTORY REMARKS**

This paper accompanies a PRE-APPEAL BRIEF REQUEST FOR REVIEW (PTO/SB/33). The arguments herein are in response to the final action of June 9, 2005. A Notice of Appeal is submitted concurrently herewith along with the appropriate fee.

Serial Number: 09/744,866  
Attorney Docket: GIES3001/ESS

### ARGUMENT

There is a sole remaining rejection (pages 10-12 of the Office Action), namely claim 24 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement on the basis that it contains a negative limitation not explicitly set forth in the application as filed. Claim 24, in the response of September 2, 2005, was written in independent form; this required splitting claim 24 into independent claims 24 and 28; it is these two independent claims that are being contested. The other claims were canceled on September 2, 2005.

The Office Action rightly states the issue (pages 10 and 11) as whether the specification contains subject matter that reasonably conveys to one skilled in the relevant art that the inventors at the time the application was filed, had possession of the claimed invention.

The undersigned takes the position that page 13, lines 25-32 of the specification shows that the inventors had in mind the invention of the rejected claims at the time of filing. Page 13, lines 25-32, is as follows:

Furthermore it is also possible to modify the cancer cells in the cell suspension prior to the screening process, for example by labeling, by attaching particles, by triggering aggregation and/or cluster formation using, for example, suitable antibodies, enzymes, lectins, other ligands and/or receptors or crosslinking reagents, by fixing and by inducing other defined states.

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The Office Action takes the position that the quoted language is a positive recitation and cannot be basis for an exclusion.

The undersigned submits that the position in the Office Action ignores the language "it is also possible" and that this language means that applicants were in possession of the invention as now claimed in independent claims 24 and 28 at the time the application was filed, on the basis that the statement that certain modifications are "also possible" clearly conveys to one skilled in the art that such modifications may be omitted (excluded).

The Office Action justifies its position on the basis that the expressed exclusion of certain elements implies permissible inclusion of all other elements not expressly excluded. The undersigned does not understand this PTO position. In the context here, such other elements are permitted to be included whether or not the negative limitation is present.

It would seem that the Office Action is taking the position it takes on the basis that the exclusion of the claims is not explicitly set forth in the application as filed. That is not the test. The invention need not be described *ipsis verbis* in the application as filed. Ex parte Holt 19 U.S.P.Q.2d 1211 (Bd. App. 1991). The correct test in the context here is whether the language at page 13, lines 25-32 "it is also possible" discloses two embodiments where one of these embodiments is that of claims 24 and 28 of September 2, 2005. Cf. Ex parte Holt at page 1214.

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It is submitted that the rejection is not considered in logical context and is egregiously defective.

Reversal of the rejection and allowance of claims 24 and 28 (of September 2, 2005) is requested.

Respectfully submitted,  
BACON & THOMAS, PLLC

By:   
Eric S. Spector  
Registration No. 22,495

**BACON & THOMAS, PLLC**  
Customer **23364**  
625 Slaters Lane - 4<sup>th</sup> Floor  
Alexandria, VA 22314-1176  
Telephone: (703) 683-0500  
Facsimile: (703) 683-1080

Date: September 7, 2005

B&T: GIES3001/ESS